

ESTTA Tracking number: **ESTTA261879**

Filing date: **01/21/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	The North Face Apparel Corp.
Granted to Date of previous extension	01/18/2009
Address	3411 Silverside Road Wilmington, DE 19810 UNITED STATES
Attorney information	Susan M. Kayser Howrey LLP 2941 Fairview Park Drive Suites 200 and 300 Falls Church, VA 22042 UNITED STATES kaysers@howrey.com, longot@howrey.com, ipdocketing@howrey.com Phone:202-783-0800

Applicant Information

Application No	77416968	Publication date	07/22/2008
Opposition Filing Date	01/21/2009	Opposition Period Ends	01/18/2009
Applicant	T.N.F. Tropical Natural Fibras, Sociedad AnÃ³nima 200 metros al oeste del Liceo de Pavas Planta Ind. Ecopapers San JosÃ©, COSTA RICA		

Goods/Services Affected by Opposition

Class 016. All goods and services in the class are opposed, namely: Note books; Notebook paper; Paper; Paper sheets for note taking; Daily planners; Day planners; Scrapbook albums; Scrapbook pages; Scrapbooks; Time planners; Agendas; Diaries; Envelopes; Blank writing journals

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3044570	Application Date	02/23/2004
Registration Date	01/17/2006	Foreign Priority Date	NONE
Word Mark	TNF WINTER GRIP		

Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2002/05/00 First Use In Commerce: 2002/05/00 Footwear		

U.S. Registration No.	2987325	Application Date	01/12/2004
Registration Date	08/23/2005	Foreign Priority Date	NONE
Word Mark	TNF TRAIL GRIP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2001/07/20 First Use In Commerce: 2001/07/20 Footwear		

U.S. Registration No.	3454860	Application Date	04/04/2007
Registration Date	06/24/2008	Foreign Priority Date	NONE
Word Mark	THE NORTH FACE NEVER STOP EXPLORING SPEAKER SERIES		

Design Mark	<p style="text-align: center;">THE NORTH FACE NEVER STOP EXPLORING SPEAKER SERIES</p>
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2007/04/26 First Use In Commerce: 2007/04/26 Arranging seminars and lectures in the fields of adventure and endurance sports, namely, skiing, snowboarding, running, climbing, and hiking; conducting seminars and lectures in the fields of adventure and endurance sports, namely, skiing, snowboarding, running, climbing, and hiking

U.S. Application No.	77355672	Application Date	12/19/2007
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	THE NORTH FACE MASTERS
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 041. First use: Arranging and conducting athletic competitions in the field of snowboarding; Entertainment in the nature of competitions in the field of snowboarding
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U.S. Application No.	77355705	Application Date	12/19/2007
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	THE NORTH FACE MASTERS
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Design Mark	THE NORTH FACE MASTERS		
Description of Mark	NONE		
Goods/Services	Class 041. First use: Arranging and conducting athletic competitions in the field of snowboarding; Entertainment in the nature of competitions in the field of snowboarding		

U.S. Application No.	77148135	Application Date	04/04/2007
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	THE NORTH FACE ENDURANCE CHALLENGE		
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Design Mark	THE NORTH FACE ENDURANCE CHALLENGE		
Description of Mark	NONE		
Goods/Services	Class 041. First use: Organizing exhibitions for sporting purposes, namely, events in the fields of skiing, snowboarding, running, climbing, and hiking		

U.S. Registration No.	3538773	Application Date	01/23/2006
Registration Date	11/25/2008	Foreign Priority Date	NONE

Word Mark	THE NORTH FACE		
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Design Mark	
Description of Mark	<p>The mark consists of the literal element "THE NORTH FACE" in white letters in a solid red square, with the design element consisting of three arcs emanating from the right of each word.</p>
Goods/Services	<p>Class 009. First use: First Use: 1989/01/25 First Use In Commerce: 1989/01/25 Computer bags</p> <p>Class 018. First use: First Use: 1989/01/25 First Use In Commerce: 1989/01/25 All purpose sporting bags, backpacks, day packs, knapsacks, rucksacks, book bags, tote bags, handbags, duffel bags, knap sacks and duffel sacks, messenger bags, hip and lumbar packs, hip belts, shoulder bags, messenger bags, book bags, waist packs, fanny packs, day packs, shoulder bags, satchels, mountaineering bags, Boston bags, internal frame packs and external frame packs, backpack bottle pockets, rain covers used to cover the aforesaid; hydration packs, namely, backpack hydration systems consisting of a backpack, a reservoir, and a mouthpiece connected to the reservoir by a tube; backpack shoulder harnesses; parts and fittings for all the aforesaid goods; walking sticks, alpenstocks, umbrellas, and parasols</p> <p>Class 020. First use: First Use: 1989/01/25 First Use In Commerce: 1989/01/25 Sleeping bags; covers for sleeping bags; sleeping bag pads; sleeping bag liners; sacks for carrying and storing sleeping bags; non-metal tent poles and tent stakes</p> <p>Class 021. First use: First Use: 1989/01/25 First Use In Commerce: 1989/01/25 Hydration packs, namely, hydration system consisting of a reservoir and a mouthpiece connected to the reservoir by a tube</p> <p>Class 022. First use: First Use: 1989/01/25 First Use In Commerce: 1989/01/25 Tents; tent accessories, namely, tent storage bags, rain flies, vinyl ground cloths, tent pole storage sacks, and gear loft platforms used for storage</p> <p>Class 025. First use: First Use: 1989/01/25 First Use In Commerce: 1989/01/25 Clothing, namely, men's, women's, and children's T-shirts, shirts, tops, sweatshirts, sweatpants, pants, side zip pants, shorts, trousers, jeans, vests, parkas, anoraks, coats, jackets, wind-resistant jackets, jacket hoods, pullovers, sweaters, coveralls, underwear, thermal underwear, boxer briefs, sleepwear, lingerie, loungewear, hosiery, socks, tights, gloves, mittens; outerwear, namely, shells, one-piece shell suits, ski wear, ski suits, ski vests, ski jackets, ski bibs, bib overalls, bib pants, snowboard wear, snow pants, snow suits, rain wear, rain jackets, rain pants, gaiters, namely, neck gaiters, leg gaiters and ankle gaiters; skirts, skorts, dresses, swimsuits, swim trunks; footwear, namely, athletic shoes, sneakers, trail running shoes, climbing shoes, hiking shoes, slippers, climbing slippers, boots, trekking boots, hiking boots, snowshoes, clogs, sandals; headgear, namely, caps, hats, headbands, bandanas, scarves, earbands, earmuffs, balaclavas, visors, beanies; belts</p> <p>Class 035. First use: First Use: 1989/01/25 First Use In Commerce: 1989/01/25 On-line retail store services, retail store services, mail order, catalogue and distributorship services, all featuring camping and outdoor gear and equipment,</p>

	books, food, hardware, clothing, sportswear, eyewear, footwear, headgear, sports equipment and related accessories
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U.S. Registration No.	3294605	Application Date	02/03/2004
Registration Date	09/18/2007	Foreign Priority Date	NONE
Word Mark	THE NORTH FACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1968/06/00 First Use In Commerce: 1969/03/00 Retail store, mail order, and distributorship services in the fields of camping and outdoor gear, books, food, hardware and sports equipment		

U.S. Registration No.	3294604	Application Date	02/03/2004
Registration Date	09/18/2007	Foreign Priority Date	NONE
Word Mark	THE NORTH FACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1966/00/00 First Use In Commerce: 1966/00/00 Retail store, mail order, and distributorship services in the fields of camping and outdoor gear, books, food, hardware and sports equipment		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	TNF		

Goods/Services	bags, packs, clothing
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Attachments	78372082#TMSN.jpeg (1 page)(bytes) 78350434#TMSN.jpeg (1 page)(bytes) 77148131#TMSN.jpeg (1 page)(bytes) 77355672#TMSN.jpeg (1 page)(bytes) 77355705#TMSN.jpeg (1 page)(bytes) 77148135#TMSN.jpeg (1 page)(bytes) 78797140#TMSN.jpeg (1 page)(bytes) 78361558#TMSN.jpeg (1 page)(bytes) 78361524#TMSN.jpeg (1 page)(bytes) Notice of Opposition.TNF ECOPAPERS.pdf (6 pages)(308910 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/susan m kayser/
Name	Susan M. Kayser
Date	01/21/2009

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

The North Face Apparel Corp.,	§	
	§	Opposition No. _____
Opposer,	§	
	§	Application Serial No. 77/416,968
v.	§	
	§	Mark: TNF ECOPAPERS (stylized)
T.N.F. Tropical Natural Fibras,	§	
Sociedad Anónima	§	Filed: March 8, 2008
	§	
Applicant.	§	Published: July 22, 2008
_____	§	

NOTICE OF OPPOSITION

The North Face Apparel Corp., a Delaware corporation, with its principal place of business at 3411 Silverside Road, Wilmington, Delaware 19810, believes it will be damaged by the registration of the mark shown in Application Serial No. 77/416,968, and therefore opposes registration of this mark under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063.

Application Serial No. 77/416,698, for the mark TNF ECOPAPERS (stylized) was filed by T.N.F. Tropical Natural Fibras, Sociedad Anónima on March 8, 2008, for “Note books; Notebook paper; Paper; Paper sheets for note taking; Daily planners; Day planners; Scrapbook albums; Scrapbook pages; Scrapbooks; Time planners; Agendas; Diaries; Envelopes; Blank writing journals” in International Class 16. The mark was published for opposition in the *Trademark Official Gazette* on July 22, 2008. Opposer has timely obtained extensions of time to oppose out to Sunday, January 18, 2009. With the closing of the United States Patent and

Trademark Office for the Martin Luther King, Jr. holiday and the Inauguration of President Obama, the deadline to oppose the above-captioned application is January 21, 2009.

As grounds for the opposition, Opposer alleges the following:

1. Since 1968, Opposer The North Face Apparel Corp. (hereinafter “The North Face”), through its predecessors-in-interest and licensee VF Outdoor, Inc., has been engaged in the development, manufacture and sale of outdoor and athletic clothing, gear, accessories and equipment and has built a large and successful business in the outdoor clothing and related outdoor equipment field. Opposer has also developed and engaged in the sale of academic and entertainment services relating to outdoor sporting events.
2. Opposer The North Face is the owner of Registration No. 3,044,570 for TNF WINTER GRIP registered on January 17, 2006. The registration covers “Footwear” in International Class 25.
3. Opposer The North Face is the owner of Registration No. 2,987,325 for TNF TRAIL GRIP registered on August 23, 2005. The registration covers “Footwear” in International Class 25.
4. Opposer The North Face also claims common law trademark rights in the mark TNF used on or in connection with bags and packs, and clothing.
5. TNF is commonly and widely known to the public as the abbreviation for or referring to the famous mark THE NORTH FACE and trade name The North Face.
6. Opposer The North Face is also the owner of numerous registrations and

applications for registration for the mark THE NORTH FACE covering seminars and lectures in the fields of adventure and endurance sports,¹ arranging and conducting athletic competitions,² and retail store services.³

7. Opposer, through its licensee, has promoted and advertised its marks TNF, TNF TRAIL GRIP and TNF WINTER GRIP for outdoor and athletic gear through varied promotional and advertising media, and its marks THE NORTH FACE for seminars and lectures in the fields of adventure and endurance sports, arranging and conducting athletic competitions, and retail store services.
8. Upon information and belief, Applicant T.N.F. Tropical Natural Fibras, Sociedad Anónima is a Costa Rican corporation.
9. Applicant T.N.F. Tropical Natural Fibras, Sociedad Anónima filed an application on March 8, 2008, to register the mark TNF ECOPAPERS (stylized), covering

¹ THE NORTH FACE NEVER STOP EXPLORING SPEAKER SERIES (Registration 3,454,860, registered on June 24, 2008), covering “Arranging seminars and lectures in the fields of adventure and endurance sports, namely, skiing, snowboarding, running, climbing, and hiking; conducting seminars and lectures in the fields of adventure and endurance sports, namely, skiing, snowboarding, running, climbing, and hiking” in International Class 035.

² THE NORTH FACE MASTERS and Design (Application Serial No. 77/355,672, filed on December 19, 2007, allowed on August 5, 2008), covering “Arranging and conducting athletic competitions in the field of snowboarding; Entertainment in the nature of competitions in the field of snowboarding” in International Class 41; THE NORTH FACE MASTERS (Application Serial No. 77/355,705, filed on December 19, 2007, allowed on August 5, 2008), covering “Arranging and conducting athletic competitions in the field of snowboarding; Entertainment in the nature of competitions in the field of snowboarding” in International Class 41; THE NORTH FACE ENDURANCE CHALLENGE (Application Serial No. 77/148,135, filed on April 4, 2007, allowed on January 1, 2008) covering “Organizing exhibitions for sporting purposes, namely, events in the fields of skiing, snowboarding, running, climbing, and hiking” in International Class 41; THE NORTH FACE and Design (Application Serial No. 78/797,140, filed on January 23, 2006, allowed on April 15, 2008), covering “Organizing exhibitions for sporting purposes, namely, events in the fields of skiing, snowboarding, running, climbing, and hiking” in International Class 41.

³ THE NORTH FACE and Design (Registration 3,294,605, registered on September 18, 2007), covering “Retail store, mail order, and distributorship services in the fields of camping and outdoor gear, books, food, hardware and sports equipment” in International Class 035 and THE NORTH FACE (Registration 3,294,604, registered on September 18, 2007), covering “Retail store, mail order, and distributorship services in the fields of camping and outdoor gear, books, food, hardware and sports equipment” in International Class 035.

“Note books; Notebook paper; Paper; Paper sheets for note taking; Daily planners; Day planners; Scrapbook albums; Scrapbook pages; Scrapbooks; Time planners; Agendas; Diaries; Envelopes; Blank writing journals” in International Class 16.

10. Applicant T.N.F. Tropical Natural Fibras, Sociedad Anónima application has been assigned Serial No. 77/416,968.
11. Applicant’s proposed TNF ECOPAPERS (stylized) mark is substantially similar in sound, appearance and commercial impression to Opposer The North Face’s registrations for the marks TNF WINTER GRIP and TNF TRAIL GRIP, and Opposer The North Face’s common law mark TNF.
12. Opposer The North Face’s registrations for the marks TNF TRAIL GRIP and TNF WINTER GRIP, registered on August 23, 2005 and January 17, 2006, respectively, have priority over Applicant T.N.F. Tropical Natural Fibras, Sociedad Anónima’s application for the TNF ECOPAPERS (stylized) mark which was not filed until March 8, 2008.
13. Opposer The North Face’s also has priority over Applicant T.N.F. Tropical Natural Fibras, Sociedad Anónima’s application for the TNF ECOPAPERS (stylized) mark which was not filed until March 8, 2008 by virtue of its rights in the registrations and marks claimed in paragraphs 4 through 6 above.
14. Opposer will be damaged if Applicant’s mark is allowed to register given Opposer’s prior rights in the marks TNF, TNF WINTER GRIP, TNF TRAIL GRIP and the mark THE NORTH FACE for a wide variety of goods and services.
15. Opposer is not connected in any way with the Applicant or the intended use by

Applicant of the mark TNF ECOPAPERS (stylized).

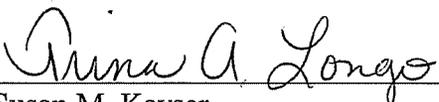
16. If Applicant's mark is registered, Applicant will receive a prima facie nationwide exclusive right to use its mark that is likely to cause confusion with Opposer's marks in commerce and, as such, would be damaging to Opposer The North Face's rights.

WHEREFORE, Opposer The North Face, based on its registrations, common law rights, and use of the marks set forth hereinabove, and the likelihood of confusion between Applicant's mark TNF ECOPAPERS (stylized) and Opposer's aforementioned marks, believes it will be damaged by registration of Applicant's mark and prays that this opposition be sustained in favor of Opposer The North Face and that Application Serial No. 77/416,968 be refused registration.

Respectfully submitted,

Date: January 21, 2009

By:



Susan M. Kayser

Trina A. Longo

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Attorneys for Opposer

The North Face Apparel Corp.

CERTIFICATE OF SERVICE

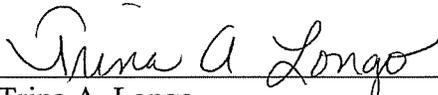
I hereby certify that true and complete copies of the foregoing Notice of Opposition have been served on Attorneys for Applicant, by mailing said copies on the 21st of January, 2009, via First Class Mail, postage prepaid to:

Arturo Perez-Guerrero
Law Offices of Arturo Perez-Guerrero
PO Box 9024163
San Juan, Puerto Rico 00902-4163

Counsel of Record for T.N.F. Tropical Natural Fibras, Sociedad Anónima

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Trina A. Longo